

## REMARKS

### **Status of the Claims**

Claims 1 - 33 are pending in the application, of which claims 9 - 33 are withdrawn from consideration pursuant to a restriction requirement. Claims 1 - 8 stand rejected. Applicants request reconsideration of the rejection of the claims and re-examination of the application.

### **Affirmation of Election**

Applicants hereby affirm the election made with traverse by phone on 6 October 2005 to prosecute the invention of Group I, i.e., claims 1 – 8. Applicants maintain the traversal of the restriction requirement and ask that the restriction requirement be withdrawn. The subject matter of claims 1 – 8, drawn to a bale of elastomer composite having certain characteristics, is seen to be sufficiently closely related to the subject matter of claims 9 - 33, drawn to a method of making a bale of elastomer composite.

### **Claims 1-8 are Patentable over Mabry et al.**

Claims 1 - 8 stand rejected under Section 103(a) over Mabry et al. (US 6,040,364). The rejection is respectfully traversed.

With respect to claim 1, Mabry et al. does not teach or suggest a bale of elastomer composite comprising elastomer composite pieces as defined by the claim. Specifically, it does not teach or suggest such bale of elastomer composite wherein the elastomer composite pieces comprise an elastomer and filler, the bale has a void volume of at least 3%, and the elastomer composite is produced by the recited method steps. In claim 1 the method for making elastomer composite is called out to comprise feeding a continuous flow of first fluid comprising elastomer latex to a mixing zone of a coagulum reactor defining an elongate coagulum zone extending from the mixing zone to a discharge end, feeding a continuous flow of second fluid comprising particulate filler under pressure to the mixing zone of the coagulum reactor to form a mixture with the elastomer latex, the mixture passing as a continuous flow to the discharge end and the particulate filler being effective to coagulate the elastomer latex, wherein feeding of the second fluid against the

first fluid within the mixing zone is sufficiently energetic to substantially completely coagulate the elastomer latex with the particulate filler prior to the discharge end, and discharging a substantially continuous flow of elastomer masterbatch from the discharge end of the coagulum reactor.

The Examiner acknowledges that Mabry et al. does not disclose a bale of elastomer composite having a void volume of at least 3%, as required by claim 1. The void volume is taught in the present specification to facilitate processing of the bales by industry equipment. In contrast, Mabry et al. does not recognize any difficulty in the processing of bales. Thus, Mabry et al. fails to recognize the problems solved by claim 1. Since Mabry et al. lacks recognition of the problem solved by the invention of claim 1 and lacks any teaching or suggestion of a void volume of the least 3% to solve the problem, Mabry et al. cannot fairly be said to disclose the invention of claim 1. On this basis alone, claim 1 and its dependent claims should be found allowable over Mabry et al.

The Examiner asserts that the inventive concept of decreasing the density of a block so as to ease a subsequent comminuting step is well-known. However, the Examiner cites no basis for such assertion. The Examiner's reliance on an assertion of general knowledge is improper, since the Examiner has failed to support this assertion with any authority. *In re Zurko*, 258 F.3<sup>rd</sup> 1379, 1385 (Fed. Cir. 2001). Also, the MPEP explains that official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. MPEP 2144.03(A). In the present case, applicant challenges the subject assertion as being not properly based upon common knowledge. See MPEP 2144.03(C). The question is whether or not the concept is well-known of decreasing the density of a bale of elastomer composite wherein the elastomer composite pieces comprise an elastomer and filler and the elastomer composite is produced by the steps recited in claim 1. Applicant respectfully submits that the Examiner erred in failing to address this issue and by addressing instead the different and incorrect issue of whether it is well-known to decrease the density of a block so as to ease a subsequent comminuting step. In any

event, however, the Examiner also has failed to support even the position that it is well-known to decrease the density of a block so as to ease a subsequent comminuting step.

With respect to independent claim 5, Mabry et al. does not teach or suggest a bale of elastomer composite comprising elastomer composite pieces, wherein the elastomer composite pieces comprise an elastomer and filler, wherein the bale has a void volume of at least 3%, and wherein the elastomer composite pieces have the form of short strips that are approximately 40 mm to 60 mm long, approximately 5 mm to 10 mm wide, and approximately 5 mm to 10 mm thick.

In this regard, the Examiner acknowledges that Mabry et al. does not disclose a bale of elastomer composite pieces having a planar form. For this reason alone, claim 5 is patentable over Mabry et al. The Examiner asserts that it is well-known to choose the size and shape of particles compressed into a bale or block so as to achieve a desired compaction with respect to void volume. However, here, again, the Examiner cites no basis for such assertion. Thus, reliance on this assertion of general knowledge, unsupported by authority, is improper for the reasons discussed above.

In addition, the comments above regarding patentability based on the bale having a void volume of at least 3% are incorporated here by reference as being applicable also to claim 5.

With respect to independent claim 6 and its dependent claim 7, Mabry et al. fails to teach or suggest a bale of elastomer composite comprising elastomer composite pieces, wherein the elastomer composite pieces comprise an elastomer and filler, wherein the bale has a void volume of at least 3% and wherein the elastomer composite pieces have the form of pellets. In this regard, the comments above regarding patentability based on the bale having a void volume of at least 3% are incorporated here by reference as being applicable also to claims 6 and 7.

Also with respect to claims 5 and 7, the Examiner acknowledges that Mabry et al. fails to disclose the particle size of the pieces called out in the claims. Claims 5 and 7 are patentable for this additional, independently sufficient reason. While the Examiner

bale or block so as to achieve a desired compaction with respect to void volume, the Examiner cites no basis for such assertion of general knowledge, and reliance on this assertion, unsupported by authority, is improper for the reasons discussed above. Moreover, the Examiner cites no authority or prior art which provides any motivation to choose the invention defined by the subject claims.

With respect to independent claim 8, Mabry et al. fails to teach or suggest a bale of elastomer composite comprising elastomer composite pieces, wherein the elastomer composite pieces comprise an elastomer and filler, wherein the bale has a void volume of at least 3% and wherein the elastomer composite pieces have a Mooney viscosity of at least 100. In addition, the comments above regarding patentability based on the bale having a void volume of at least 3% are incorporated here by reference as being applicable also to claim 8.

#### **Conclusion**

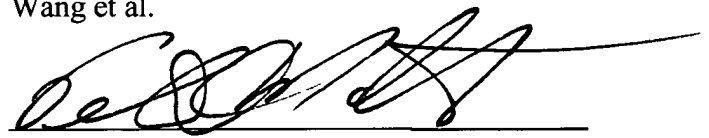
In view of the foregoing amendments and remarks, applicants respectfully request allowance of all claims under consideration in the application and that the application be passed to issue.

Respectfully submitted,

Wang et al.

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Date



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